

REMARKS

In the February 28, 2005 Office Action, the Examiner noted that claims 1-29 were pending in the application; indicated that the certified copy of priority application had not been received; and rejected claims 1-29 under 35 U.S.C. § 103(a). In rejecting the claims, U.S. Patents 5,774,534 to Mayer; 6,219,639 to Bakis et al.; 6,463,415 to St. John; 6,571,279 to Herz et al.; 6,587,838 to Esposito et al.; (References A-C, E and F, respectively, in the October 4, 2004 Office Action); and 6,178,446 to Gerszberg et al. (Reference B in the February 28, 2005 Office Action) were cited. Claims 1-29 remain in the case. The Examiner's rejections are traversed below.

Priority Application

On page 2 of the Office Action, the Examiner indicated that "the entire priority document is not in the file and thereby a complete copy would be required." Submitted herewith is a copy of the priority application as published which was downloaded from the Japanese Industrial Property Digital Library maintained by the National Center for Industrial Property Information and Training. If another certified copy of the priority application is required, the Examiner is respectfully requested to contact the undersigned by telephone to expedite the process of obtaining another certified copy.

Rejections under 35 U.S.C. § 103(a)

On pages 2-5 of the Office Action, claims 1, 2, 7, 10, 24, 25 and 27-29 were rejected under 35 USC § 103(a) as unpatentable over Gerszberg et al. "in view of an obvious variation." As illustrated in Figs. 9A and 9B, the system disclosed by Gerszberg et al. describes a service for a subscriber who, "upon viewing a commercial on a display terminal can click on the advertisement to alert the advertiser that the customer is interested in the item that is being advertised" (column 2, lines 33-46) so that the subscriber can receive "an information pamphlet ... [or] a coupon, [or order] the product directly from the manufacturer or distributor" (column 2, lines 36-48). In response to selection of the advertisement by the subscriber, a subscriber request message is generated containing "the subscriber's identity, the channel number that the subscriber was watching ... and a message type" (column 9, lines 44-48). This information is used to query a database "to determine the identity of the advertisement that was broadcasted by comparing the channel number and the time at which the advertisement was broadcasted with the channel number and time stored in the database" (column 9, lines 20-23) as indicated in block 410 in Fig. 9A.

In comparison, claim 1 recites that "commercial message broadcast designation information contained in the commercial message information and designating at least the commercial message broadcast" (claim 1, lines 9-10) is received from a client after "broadcasting, in parallel, both the commercial broadcast and the commercial message information relating to the commercial message broadcast" (claim 1, lines 6-8), as indicated in block S410 in Fig. 4 and the XML data associated with reference numeral 50 in Fig. 8. By providing the "commercial message broadcast designation information" in the commercial message information, no table look-up as taught by Gerszberg et al. is required.

Nothing has been cited in Gerszberg et al. (or any of the other patents cited in rejecting the claims) that would suggest including commercial message broadcast designation information in what is transmitted with the commercial message broadcast, so that a request can be immediately processed without requiring knowledge of when the commercial message is broadcast. In the system taught by Gerszberg et al., only the broadcaster or someone who has knowledge of when the broadcasts occur, is able to process requests from clients or (using the terminology of Gerszberg et al.) subscribers. As a result, it is possible for "a commerce out-sourcing center" (claim 10, lines 4-5) to generate "commercial message information ... [and] a commercial message broadcast related thereto" (claim 10, lines 3-4) and receive "commercial message broadcast designation information obtained from the commercial message information and designating at least the commercial message broadcast" (claim 10, lines 12-13) to subsequently process the request without requiring any knowledge of when the broadcast occurred. Claims 28 and 27 recite systems that perform the methods recited in claims 1 and 10, respectively, and therefore, it is submitted that claims 1, 10, 27 and 28, as well as claims 2, 7, 24 and 25 which depend from claims 1 and 10, patentably distinguish over Gerszberg et al. for the reasons discussed above.

Claim 29 recites a commerce information management apparatus which receives information after a "client sees a commercial message broadcast, performs an instruction for displaying commercial message information related to the commercial message broadcast and **purchases** the merchandise or the service (claim 29, lines 7-9, emphasis added). As noted above, the teaching of Gerszberg et al. relates to supplying information **prior** to purchase by a customer, not as a result of a purchase made by a customer. For the above reasons, it is submitted that claim 29 patentably distinguishes over Gerszberg et al.

The remaining references were used in various combinations on pages 6-23 to reject claims 4-6, 8, 9, 11-23 and 26. Nothing was cited or has been found in any of these references teaching or suggesting modification or Gerszberg et al. to overcome the deficiencies discussed

above with respect to claim 1, 10 and 27-29. Therefore, it is submitted that all of the claims patentably distinguish over the applied art.

Response to Arguments

In the Response to Arguments on pages 24 and 25 of the Office Action, it was asserted that the Amendment filed January 4, 2005 did not contain "an adequate traverse because Applicant has not specifically pointed out the supposed errors in the Examiner's action which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art" (page 24, lines 11-14, emphasis in original), citing "27 CFR 1.104(d)(2), MPEP 707.07(a)" and *in re Boon* 439 F2d 724, 728, 169 USPQ 231, 234 (CCPA 1971). Assuming that "27 CFR" was a typographical error and the Examiner intended to cite Title 37 of the CFR, it is submitted that none of these citations support the assertion that an adequate traverse requires "stating why the noticed fact is not considered to be common knowledge or well-known in the art."

In the July 1, 2004 edition, Title 37 of the CFR § 1.104(d)(2) states

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the Applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the Applicant and other persons.

Thus, according to 37 CFR § 1.104(d)(2) an affidavit is required "when called for the by Applicant" without any requirement of "stating why the noticed fact is not considered to be common knowledge or well-known in the art."

As a general matter, nothing in the Manual of Patenting **Examining Procedure** (emphasis added) can impose a greater burden on Applicants than is set forth in Title 37 of the CFR. Therefore, anything contained in MPEP § 707.07(a) is not a requirement that an Applicant must meet. Furthermore, MPEP § 707.07(a) relates to "Complete Action on Formal Matters" not what must be submitted by Applicants. Therefore, MPEP § 707.07(a) is irrelevant.

Similarly, *in re Boon* is not related to actions taken by Applicants. Rather, this decision of the CCPA relates to "the board's 'amplified reasons in support'" where "board" refers to the Board of Appeals, not an Examiner and the "reasons" were citation of a dictionary, not a bald assertion that there was general knowledge in the art that would suggest modification of a reference, without citation of any evidence. Thus, any requirements placed on Applicants by *In re Boon* do not apply in a situation where an Examiner fails to cite support for an assertion of common knowledge in the art in response to a request in accordance with 37 CFR § 1.104(d)(2).

For the reasons set forth above, it is improper for the Examiner to take as "admitted" the assertions of common knowledge in the art in the October 4, 2004 Office Action.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not reach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-29 are in a condition suitable for allowance. Entry of the Amendment, reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 8/12/05

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501